

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: DEX-0283
Inventors: Salceda et al.
Serial No.: 10/001,870
Filing Date: November 20, 2001
Examiner: Horlick, Kenneth R.
Group Art Unit: 1637
Title: Compositions and Methods Relating to
Prostate Specific Genes and Proteins

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On October 21, 2003


Kathleen A. Tyrrell, Registration No. 38,850

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Commissioner for Patents
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Alexandria, VA 22313-1450

Dear Sir:

Reply to Restriction Requirement

This is a reply to the Restriction Requirement mailed September 22, 2002 setting a one (1) month statutory period for response. Please enter the following remarks into the record.

Remarks begin on page 2.

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Attorney Docket No.: DEX-0283
Inventors: Salceda et al.
Serial No.: 10/001,870
Filing Date: November 20, 2001
Page 2

REMARKS

Claims 1-17 are pending in the instant application. Claims 1-17 have been subjected to a Restriction Requirement as follows:

Group I, claims 1-5, 7-9 and 15 (partial), drawn to nucleic acids, vectors, host cells and methods of making a polypeptide, classified in class 536, subclass 23.1, and class 435, subclasses 69.1, 320.1 and 325, for example;

Group II, claim 10-11, drawn to polypeptides, classified in class 530, subclass 350, for example;

Group III, claims 12 and 15 (partial), drawn to an antibody, classified in class 530, subclass 387.1, for example;

Group IV, claims 6 and 14 (partial), drawn to a method of determining the presence of a nucleic acid, classified in class 435, subclass 6;

Group V, claims 13 and 14 (partial), drawn to a method of determining the presence of a polypeptide, classified in class 435, subclass 7.1, for example;

Group VI, claim 16, drawn to a method for treating a patient with prostate cancer by administering an antibody, classified in class 514, subclass 2, for example;

Group VII, claim 17 (partial), drawn to a vaccine comprising

Attorney Docket No.: DEX-0283
Inventors: Salceda et al.
Serial No.: 10/001,870
Filing Date: November 20, 2001
Page 3

a polypeptide, classified in class 514, subclass 2; and
Group VIII, claim 17 (partial), drawn to a vaccine
comprising a nucleic acid, classified in class 514, subclass 44.

The Examiner suggests that these Groups are distinct.
Specifically, with respect to Groups I, II, III, VII and
VIII, the Examiner suggests that the claims are drawn to
different products having different structures and functions.

With respect to Groups I and IV, and Groups III and (V,VI),
the Examiner has acknowledged their relationship as product and
process of use. However, the Examiner suggests that the Groups
are distinct because the products can be used in materially
different methods or processes.

With respect to Groups I and (V, VI), Groups II and (IV, V
and VI), Groups III and IV, Groups IV-VI, and Groups (IV-VI) and
(VII,VIII), the Examiner suggests that the Groups are unrelated
because the different Groups are not required for one another.

Further, the Examiner suggests that each of Groups I-VIII
are drawn to a multitude of nucleic acids, polypeptides, and
antibodies thereto which are independent and distinct. Thus, the
Examiner is also requiring election of a single nucleic acid,
polypeptide or antibody.

Applicants respectfully traverse this Restriction

Attorney Docket No.: DEX-0283
Inventors: Salceda et al.
Serial No.: 10/001,870
Filing Date: November 20, 2001
Page 4

Requirement.

MPEP §803 provides two criteria which must be met for a restriction requirement to be proper. The first is that the inventions be independent or distinct. The second is that there would be a serious burden on the Examiner if the restriction is not required. A search of prior art relating to an elected nucleic acid, polypeptide or antibody would also reveal any references teaching uses for the nucleic acid, polypeptide or antibody. Accordingly, Applicants believe that searching of all the claims, at least when limited to elected nucleic acids or polypeptides is overlapping and would not place an undue burden on the Examiner if the Restriction is not made.

Thus, since this Restriction Requirement does not meet both criteria as set forth in MPEP § 803 to be proper, reconsideration and withdrawal of this Restriction Requirement is respectfully requested.

In addition, with respect to the election of a single sequence, MPEP § 803.04 clearly states that a reasonable number of nucleotide sequences, normally ten sequences, can be claimed in a single application. Accordingly, withdrawal of this sequence election requirement and reconsideration to include a more reasonable number of at least 10 sequences in accordance

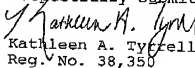
Attorney Docket No.: DEX-0283
Inventors: Salceda et al.
Serial No.: 10/001,870
Filing Date: November 20, 2001
Page 5

with MPEP § 803.04 is also respectfully requested.

However, in an earnest effort to advance the prosecution of this case, Applicants elect Group I, claims 1-5, 7-9 and 15, SEQ ID NO:68 encoding SEQ ID NO:179, with traverse.

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record.

Respectfully submitted,


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Date: October 21, 2003

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